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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,299	01/31/2002	Leroy E. Hood	P-IS 5150	2563
41552 7590 03/21/2007 MCDERMOTT, WILL & EMERY 4370 LA JOLLA VILLAGE DRIVE, SUITE 700 SAN DIEGO, CA 92122			EXAMINER SMITH, CAROLYN L	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 03/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/062,299

Applicant(s)

HOOD ET AL.

Examiner

Carolyn L. Smith

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 27 February 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 22-35.
Claim(s) withdrawn from consideration: 1-21 and 36-49.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: The proposed claim amendments add limitations, such as "values for" and "providing an output to a user said determination of said multidimensional coordinate point", which raise new issues that would require further consideration and/or search.

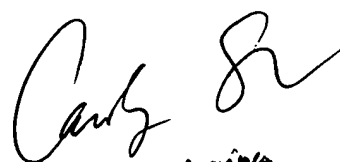
Continuation of 11. does NOT place the application in condition for allowance because: the proposed limitations would require further consideration and/or search. Because the proposed claim amendments have not been entered, all of the rejections from the previous FINAL office action, mailed 8/28/06, are maintained.

35 USC 101

Applicants' argue that Federal case law is clear that physical transformation is not required to satisfy the statutory criteria of 35 USC 101. This statement is found unpersuasive. It is noted that the examiner has not "required" that the claims recite a physical transformation or interaction with a computer. The previous office action stated that where the claims do not recite a physical transformation of matter, they MAY be statutory where they recite a concrete, tangible and useful result; i.e. practical application. This is in accordance with the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (published in the O.G. notice (1300 OG 142) on 11/22/2005) and the In re Lundgren decision. Applicants remaining arguments regarding the 35 USC 101 rejection are based on proposed amendments which have not been entered and are therefore unpersuasive.

35 USC 102 rejection

Applicants summarize the rejection. Applicants argue that the Office fails to give patentable weight to Applicants showing that the invention claims a point containing n parameters. This statement is found unpersuasive as Stoughton et al. disclose use of positionally addressable transcript microarrays which are ordered and reproducible matrices for easy comparison with each other and capable of containing single sites per specific mRNA (col. 45, lines 17-39, col. 46, lines 58-67, and col. 51, lines 39-49) and making measurements of graded drug exposure and of graded levels of modification/perturbation control parameters (col. 52, lines 1-17) wherein the microarrays inherently involve mRNA locations containing x and y dimensions (multidimensional coordinate points) for components of a physically perturbed system including n parameters (i.e. drug exposure and levels of perturbation) corresponding to the number of measured components within the biochemical system, as stated in instant claims 22, 24, and 30. It is noted that "n" is not limited to any particular number and can even be zero. Applicants state that "n" in n parameters corresponds to the number of measured components within a biochemical or constituent system and argue that none of the passages relied on by the Office support the contention that the cited art describes multidimensional coordinate point as claimed. This statement is found unpersuasive as drug exposure and levels of perturbation, as mentioned above, corresponds to the number of measured components. Applicants are reminded that "corresponding" is broad claim language and has been interpreted broadly. All of the limitations in the instant claims, filed 6/9/06, have been addressed and are recited in the prior art, as described in the prior art rejection of the FINAL office action, mailed 8/28/06. It is reiterated that Stoughton et al. disclose use of positionally addressable transcript microarrays which are ordered and reproducible matrices for easy comparison with each other and capable of containing single sites per specific mRNA (col. 45, lines 17-39, col. 46, lines 58-67, and col. 51, lines 39-49) and making measurements of graded drug exposure and of graded levels of modification/perturbation control parameters (col. 52, lines 1-17) wherein the microarrays inherently involve mRNA locations containing x and y dimensions (multidimensional coordinate points) for components of a physically perturbed system including n parameters (i.e. drug exposure and levels of perturbation) corresponding to the number of measured components within the biochemical system. Stoughton et al. disclose determining the overall goodness of fit of the network model (network-associated expression region) from the individual goodnesses of fit of each observed component (abstract), which also represents determining the multidimensional coordinate point representing a data element of a set of components in a network. Stoughton et al. disclose observing a system's response to known inputs via gene expression and/or protein abundances (col. 2, first paragraph). Applicants argue that the claimed multidimensional coordinate point refers to a coordinate or point corresponding to the number of measured components of a biochemical system and distinguish the passage at columns 45, 46, 51, and 52 because they are directed to the production of arrays where analytes are produced at different locations, labeled probes on a microarray, and the amount and quantity of individual gene measurements. Applicants further argue that different locations within an array do not describe a "multidimensional coordinate point" as claimed because locations in an array are non-analogous to parameters of measured components included in a multidimensional coordinate point. This statement is found unpersuasive as different locations (wells or spots) on an array have x and y coordinate dimensions which are multidimensional (2 dimensions), and reasonably represent "points". Applicants are reminded that broad claim language such as "representing" and "corresponding" have been interpreted broadly and reasonably. Drug exposure and levels of perturbation reasonably represent "parameters". Applicants argue that they fail to discern how an x/y coordinate of a location within a microarray describes a multicoordinate point representing "values of" n measured components. This statement is directed toward claim amendments which have not been entered and is therefore unpersuasive. Applicants' arguments are deemed unpersuasive for the reasons given above.


Av 1631 examiner
3/16/07